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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,037	12/22/2005	Kiyotaka Inokami	2224-0251PUS1	6325

2292	7590	10/05/2007
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EXAMINER	
KOSACK, JOSEPH R	

ART UNIT	PAPER NUMBER
1626	

NOTIFICATION DATE	DELIVERY MODE
10/05/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

# Office Action Summary

Application No.

10/562,037

Applicant(s)

INOKAMI, KIYOTAKA

Examiner

Joseph Kosack

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1, 3, 5, 7, and 9-11 are pending in the instant application.

#### ***Amendments***

The amendment filed July 19, 2007 has been acknowledged and has been entered into the application file.

#### ***Information Disclosure Statement***

The Information Disclosure Statements filed on April 09, 2007 and July 20, 2007 have been considered fully by the Examiner.

#### ***Response to Arguments***

Applicant's arguments have been considered fully, but are not found persuasive for the following reasons.

Firstly, there is no mention of a priority document for the instant application prior to the arguments supplied by the Applicant on July 19, 2007. A review of the application file showed that no claim for foreign priority was made in the declaration, and no claim for foreign priority was shown on the WIPO publication of the application during the international stage. Additionally, there is no priority date listed on the M903 form mailed to Applicant on April 06, 2006. Therefore, Katsuhiko et al. cannot be disqualified as prior art at the time being.

Secondly, the claims do not require that a non-lactone adduct ultraviolet-absorbing compound be used in the claims. Therefore, Katsuhiko and Inokami still read on the claims.

Thirdly, even if Mori is not directed to an aqueous emulsion, Inokami is directed to an aqueous emulsion and therefore meets the requirement of the claims.

Finally, as stated in the previous action, the patentability of a product does not depend upon its method of production. Applicant's point is noted about the polyisocyanates, but is not found to be persuasive since the prior art, esp. Inokami teach the reaction of the polyol with an organic polyisocyanate. See page 7 of the action of April 4, 2007.

The amendments are persuasive for the rejection of claim 1 under 35 U.S.C. 112, first paragraph and the rejection of claims 9-11 under 35 U.S.C. 112, second paragraph and these rejections are withdrawn. As claims 2, 4, 6, and 8 have been cancelled, all rejections are withdrawn for those claims.

However, the rejection of claims 1, 3, 5, 7, and 9-11 are maintained under 35 U.S.C. 102 and 35 U.S.C. 103 for the reasons of record of April 4, 2007.

### **Conclusion**

Claims 1, 3, 5, 7, and 9-11 are rejected.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any


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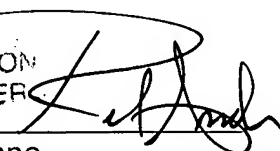
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Kosack whose telephone number is (571)-272-5575. The examiner can normally be reached on M-F 6:30 A.M. until 4:00 P.M. The examiner has every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>re</sup>Kane can be reached on (571)-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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